

**REMARKS**

Claims 1 through 3, 5 through 20, and 22 through 34 are currently pending in the application.

Claims 4 and 21 have been cancelled.

Claims 9 through 17 and 26 through 34 are withdrawn from consideration as being drawn to a non-elected invention.

Claims 1 through 8 and 18 through 25 stand rejected.

Claims 1 through 3, 5 through 8, 18 through 20 and 22 through 25 have been amended in this amendment.

In response to the objection to the drawings under 37 CFR 1.83(a), Applicants have amended the claims to remove references to "a second pattern having no through holes." Accordingly, the drawings comply with 37 CFR 1.83(a).

This amendment is in response to the Office Action of July 25, 2003.

**35 U.S.C. § 102(b) Rejections**

**Rejection Based on Sakemi et al. (U.S. Patent 5,655,704)**

Claims 1 through 4, 6 through 8, 18 through 21 and 23 through 25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sakemi et al. (U.S. Patent 5,655,704). After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants submit that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants have amended independent claims 1 and 18 to clearly set forth as an element of the presently claimed invention a substrate which has electrical contacts which do not protrude from the surface of the substrate calling for "a substrate having an upper surface, and bearing conductive sites comprising one of recessed sites and level sites with respect to said upper

surface”. With regard to the claims as amended, Sakemi fails to identically describe, either expressly or inherently, the element of the presently claimed invention calling for “a substrate having an upper surface, and bearing conductive sites comprising one of recessed sites and level sites with respect to said upper surface.” Support for the amendment can be found in the specification, page 8, lines 13 through 17: “The method of the invention may be applied to the placement of conductive spheres 12 on any conductive site<sup>14</sup>, whether the site, e.g. bondpad projects from the substrate 20 or is recessed therein.”

Sakemi, on the other hand describes “contacts” which stand out from the surface of the substrate. Note that the reference illustrates only electrical contacts which stand out from the surface. See Fig. 4. Furthermore, language in the reference indicates that it does not contemplate recessed bond pads. For example, as recognized in Applicants’ disclosure, the use of recessed contacts may eliminate the need for applying flux to the surface of the contacts. See page 5, lines 22 through 24, where the specification sets forth that flux may not be needed when using “recessed bondpads.” In contrast, in column 4, lines 57 and 58, Sakemi indicates that with respect to the invention described therein, flux is required (“[f]lux is applied beforehand to the top of each electrode on the workpiece”). Other parts of Sakemi support the idea that the application of flux is a requirement, such as column 6, lines 23 through 27, in which it is indicated that flux is applied to prevent the solder ball from “dislocating from the electrode.” Applicants respectfully submit that claims 1 and 18 are thus allowable, and claims 2, 3, 6 through 8, 19, 20 and 23 through 25 are allowable as depending from allowable independent claims 1 and 18 because the cited prior art does not identically describe the elements of the presently claimed invention in the same detail as set forth in the presently amended claims to anticipate the presently claimed invention under 35 U.S.C. § 102.

### **35 U.S.C. § 103(a) Rejections**

#### **Obviousness Rejection Based on Sakemi et al. (U.S. Patent 5,655,704)**

Claims 5 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakemi et al. (U.S. Patent 5,655,704). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants further submit that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

Applicant respectfully submits that any rejection of the presently claimed invention based upon the cited prior art fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention because Sakemi, as explained above, fails to "teach or suggest all of the claim limitations" in that it fails to teach or suggest the claim limitation or the presently claimed invention calling for "a substrate having an upper surface, and bearing conductive sites comprising one of recessed sites and level sites with respect to said upper surface." Claims 5 and 22 are thus respectfully deemed allowable.

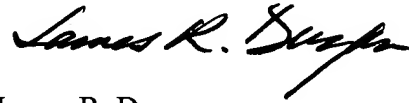
In response to the "Response to Arguments" section of the Office Action where it is asserted that the limitations added to claims 1 and 18 by Applicants in the previous response are taught by Sakemi, Applicants have deleted such claim limitations for the presently amended independent claims 1 and 18. The limitations "a plurality of holes extending across said stencil plate" and "a hopper extending across said upper surface of said stencil plate" have thus been deleted.

In summary for the reasons set forth herein, Applicants submit that claims 1 through 8 and 18 through 33 are clearly allowable over the cited prior art.

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Applicants request the allowance of claims 1, 2, 3, 5, 6, 7, 8, 18, 19, 20, 22, 23, 24 and 25 and the case passed for issue.

Respectfully submitted,



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